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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of :

Joseph C. Walsh

Serial No.: 10/027,744

Filed: December 20, 2001

For: **PROCESS FOR MAKING A DISPENSING ASSEMBLY**

)
)
)
) **Group Art Unit: 3721**
) **Examiner: Sameh H. Tawfik**
) **Atty Dkt. PP 5.71(c)**
)

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REQUEST FOR WITHDRAWAL OF FINALITY

**To: Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Applicant respectfully requests that the finality of the Office action mailed January 30, 2004, be withdrawn for the reasons set forth below.

In the Office action, the Examiner applies new grounds of rejection to all of the pending claims. The Examiner provides the following explanation for nevertheless making the action final:

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §609(B)(2)(i).

(bold type in original)

The Examiner's statement appears to be in error since none of the new references applied by the Examiner in the final Office action were cited

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Art Unit 3721
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on applicant's information disclosure statement. Specifically, the Examiner applies Goldstein (U.S. 2,701,679) and Knauf (U.S. 5,415,910) to reject applicant's claims. Applicant's information disclosure statement filed October 10, 2004, however, cites only Ours et al. (U.S. 6,474,046) and Ours et al. (U.S. 6,474,040). Accordingly, it is not seen how applicant's submission of the information disclosure statement in question could possibly have "prompted the new ground(s) of rejection" as asserted by the Examiner.

The Examiner's reliance on MPEP §609(B)(2)(i) is also not understood. This section of the MPEP reads as follows:

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is **used in a new ground of rejection** on unamended claims, the next Office action **will not be made final** since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.

(emphasis added)

At the outset, this section of the MPEP applies *only* to situations in which information cited by applicant is *used* in a new ground of rejection. As pointed out above, however, the Examiner did not use either of the references cited by applicant in the final rejection. Further, MPEP §609(B)(2)(i) only specifies a situation in which an Office action *will not be made final*; accordingly, this section cannot serve as the basis for making an action final.

It is noted that MPEP §609(B)(2)(ii) does authorize a final Office action in certain circumstances; once again, however, this section is relevant *only* when the reference cited is *used* in a new ground of rejection.

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For the reasons set forth above, applicant respectfully asserts that the Office action mailed January 30, 2004, was improperly made final. Accordingly, applicant requests that the finality be withdrawn.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By 

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NAME: Examiner Sameh H. Tawfik
Group Art Unit 3721

FAX NO.: (703) 872-9306

LOCATION: U.S. Patent and Trademark Office

FROM: Michael A. Goodwin, Esq. - KLAAS, LAW, O'MEARA & MALKIN, P.C.

RE: U.S. Patent Application Serial No. 10/027,744
Our Ref.: PP 5.71(c)

TOTAL NO. OF PAGES (Including Transmittal Sheet) -7-

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COMMENTS: Please find attached the following documents: Transmittal Form, Fee
Transmittal for FY 2004 (in duplicate) and Request for Withdrawal of Finality (3 pages).

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PTO/SB/21 (05-03)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number	10/027,744
Filing Date	December 20, 2001
First Named Inventor	Joseph C. Walsh
Art Unit	3721
Examiner Name	Sameh H. Tawfik
Attorney Docket Number	PP 5.71(c)

Total Number of Pages in This Submission

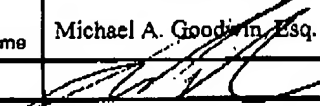
6

ENCLOSURES (Check all that apply)

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|--|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form
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<input checked="" type="checkbox"/> Amendment/Reply
<input checked="" type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Response to Missing Parts/Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation
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<input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Group
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<input type="checkbox"/> Status Letter
<input type="checkbox"/> Other Enclosure(s) (please identify below): |
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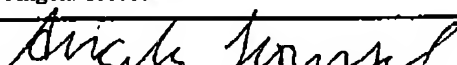
Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Michael A. Goodwin, Esq.
Signature	
Date	February 3, 2004

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$)-0-

Complete if Known

Application Number 10/027,744
 Filing Date December 20, 2001
 First Named Inventor Joseph C. Walsh
 Examiner Name Sameh H. Tawfik
 Art Unit 3721
 Attorney Docket No. PP 5.71(c)

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None
☒ Deposit Account:

Deposit Account Number 11-1150
 Deposit Account Name Klaas, Law, O'Meara & Malkin, P.C.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)-0-

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Extra Claims Fee from below Fee Paid
 Total Claims 16 -75** = 0 X \$18.00 =
 Independent Claims 2 -19** = 0 X \$86.00 =
 Multiple Dependent

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 88	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)-0-

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1808 180	1808 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)-0-

SUBMITTED BY

Name (Print/Type) Michael A. Goodwin, Esq.

Registration No. (Attorney/Agent) 32,697

(Complete if applicable)

Telephone (303) 298-9888

Signature

Date

February 3, 2004

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